



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/585,358	07/06/2006	Sung Cheol Yoon	29137.183.00	2782
30827	7590	03/09/2010	EXAMINER	
MCKENNA LONG & ALDRIDGE LLP			TESKIN, FRED M	
1900 K STREET, NW			ART UNIT	
WASHINGTON, DC 20006			PAPER NUMBER	
			1796	
			MAIL DATE	
			DELIVERY MODE	
			03/09/2010	
			PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/585,358	Applicant(s) YOON ET AL.	
	Examiner Fred M. Teskin	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 19-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 10-18 is/are rejected.
- 7) ☒ Claim(s) 8 and 9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>20100226</u> . | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

This Office action follows a reply filed on 12/23/2009. Per the reply, claims 3, 4 and 6 have been amended. Claims 1-22 remain pending; claims 19-22 stand withdrawn from further consideration pursuant to the restriction requirement of 06/03/2009.

The amendments made to claims 3, 4 and 6 have resulted in withdrawal of the informality objection and the rejections under Section 112, 2d paragraph, as set out in the last action.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-7 and 10-18 stand rejected under 35 U.S.C. 103(a) as being unpatentable over WO 2005/019277 A1 (all reference thereto being to the corresponding English language equivalent, US 2007/0123667 A1 to Oshima et al).

The rejection is maintained substantially as set forth in the previous Office action (see pp. 4-5 thereof) and for the reasons which follow.

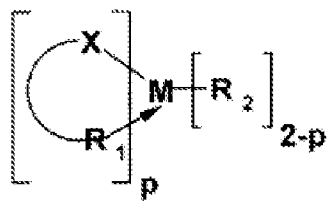
Applicants' arguments filed 12/23/2009 have been fully considered but are not persuasive of error in the repeated rejection.

Applicants contend that WO '277 does not constitute valid prior art against the present application because, it is argued, the effective filing date of the present

Art Unit: 1796

application is July 7, 2004, which is earlier than the publication date of WO '277 (March 3, 2005), and WO '277 does not have a 35 U.S.C. 102(e)(1) date (Reply, pp. 10-11). In support of the priority claim, applicants have submitted a certified translation of Korean Application No. KR 10-2004-0052612, filed July 7, 2004, to which the present application claims priority via a PCT national stage application.

To respond: the claims in a U.S. application are entitled to the benefit of a foreign priority date *if* the corresponding foreign application supports the claims in the manner required by 35 USC 112, first paragraph (see MPEP 2163.03(III)). Instantly, applicants have not alleged, much less shown, that the priority application supports the full scope of the invention as claimed in the present application. Upon review of the certified translation, examiner finds that at least claims 1, 4 and 5 hereof contain considerable subject matter which is not described, expressly or implicitly, in the priority application. In particular, claim 1 recites a procatalyst represented by formula (1):



(1)

where X is a hetero atom selected from S, O and N;

R_1 is $-\text{CH}=\text{CHR}^{20}$, $-\text{OR}^{20}$, $-\text{SR}^{20}$, $-\text{N}(\text{R}^{20})_2$, $-\text{N}=\text{NR}^{20}$, $-\text{P}(\text{R}^{20})_2$, $-\text{C}(\text{O})\text{R}^{20}$, $-\text{C}(\text{R}^{20})=\text{NR}^{20}$, $-\text{C}(\text{O})\text{OR}^{20}$, $-\text{OC}(\text{O})\text{OR}^{20}$, $-\text{OC}(\text{O})\text{R}^{20}$, $-\text{C}(\text{R}^{20})=\text{CHC}(\text{O})\text{R}^{20}$, $-\text{R}^{21}\text{C}(\text{O})\text{R}^{20}$, $-\text{R}^{21}\text{C}(\text{O})\text{OR}^{20}$ or $-\text{R}^{21}\text{OC}(\text{O})\text{R}^{20}$, in which R^{20} is a hydrogen, a halogen, a linear or branched C_{1-5} alkyl, a linear or branched C_{1-5} haloalkyl, a linear or branched C_{5-10} cycloalkyl, a linear or branched C_{2-5} alkenyl, a linear or branched C_{2-5} haloalkenyl, or an optionally substituted C_{7-24} aralkyl, and R^{21} is a C_{1-20} hydrocarbylene;

To the extent the recited formula embraces procatalysts wherein "p" is 1 or 2 and R₁ is selected from any of the enumerated chemical species, claim 1 literally reads on subject matter for which written description is not provided in the priority document (based on the content of the certified translation).

Claim 1 further recites a cocatalyst represented by a formula (2): [(R₃)-P-(R₄)_a(R₄)_b[Z(R₅)_d]_c][Ani] wherein R₃ is a hydrogen, an alkyl, or an aryl. The priority document describes a formula (2) containing an H-P- moiety and does describe the embodiments of the present invention wherein R₃ is an alkyl or an aryl (*cf.*, certified translation at page 7, lines 8-10).

Similarly, regarding claims 4 and 5, examiner finds no adequate support in the priority document for the claimed features of a group 10 metal compound represented by recited formula (4) and a palladium compound represented by recited formula (5), respectively. Indeed, the most relevant portions of the priority document concerning procatalyst structure and composition (*see*, certified translation at page 6, line 25 to page 7, line 7 and pp. 24-25) fail to specifically describe either of said claimed formulae.

Because the foreign priority document does not provide written description of the entire subject matter set forth in the present claims, as required by Section 112, first paragraph, examiner finds that claims 1-18 have an effective filing date as of the 07/05/2005 filing date of the international stage application, and not as of the filing date of the foreign priority application. Accordingly, applicants have not antedated WO '277, which was published (03/03/2005) prior to the international filing date. The continued rejection over WO '277 is therefore maintained as tenable.

Art Unit: 1796

Claims 8 and 9 stand objected to as being dependent on a rejected base claim, but would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claim. The claimed embodiments wherein the catalyst mixture is supported on an inorganic support are not disclosed nor adequately suggested in the available prior art.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner F. M. Teskin whose telephone number is (571) 272-1116. The examiner can normally be reached on Monday through Thursday from 7:00 AM - 4:30 PM, and can also be reached on alternate Fridays.

Art Unit: 1796

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on (571) 272-1114. The appropriate fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Fred M Teskin/

Primary Examiner, Art Unit 1796

Application/Control Number: 10/585,358
Art Unit: 1796

Page 7